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10/687,896	10/17/2003	Nitin Jhingan	END920030059US1 (16844)	9806
23389 7590 02/15/2012 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER CLARK, DAVID J	
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* NITIN JHINGAN
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11 Appeal 2010-008502
12 Application 10/687,896
13 Technology Center 3600
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17 Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and
18 BIBHU R. MOHANTY, *Administrative Patent Judges*.

19
20 FETTING, *Administrative Patent Judge*.

21 DECISION ON APPEAL
22
23

STATEMENT OF THE CASE¹

Nitin Jhingan (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-6 and 19-32, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellant invented a way for using instant messaging to provide and receive information about requisition orders over the Internet or other computer networks. (Specification ¶ 0001).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A method of creating and providing information about a requisition order, comprising the steps:

[1] providing an automated agent

for receiving and identifying a set of inquiries about the requisition order,

and

for each identified inquiry,

preparing an associated response;

[2] a user transmitting to the agent

one of said set of inquiries;

[3] the agent identifying the transmitted inquiry

¹ Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed November 25, 2009) and Reply Brief ("Reply Br.," filed March 16, 2010), and the Examiner's Answer ("Ans.," mailed March 16, 2010).

1 and
2 preparing the associated response;
3 [4] using an instant messaging system
4 to send said associated response from the agent to the
5 user;
6 [5] the user initiating an instant messaging session
7 with the agent
8 via the instant messaging system;
9 and
10 [6] the user and the agent creating the requisition order during
11 said instant messaging session
12 by interactively communicating with each other during
13 said instant messaging session via the instant messaging
14 system,
15 thereby eliminating the need to use a Web site to create
16 the requisition order,
17 wherein the agent helps the user create orders through a
18 chat window.

19 The Examiner relies upon the following prior art:

Monteleone	US 7,184,973 B2	Feb. 27, 2007
Katzman	US 2002/0046051 A1	Apr. 18, 2002
Chou	US 2002/0099796 A1	Jul. 25, 2002

20 Claims 1-6, 19-22, and 24-32 stand rejected under 35 U.S.C. § 103(a) as
21 unpatentable over Chou and Katzman.

22 Claim 23 stands rejected under 35 U.S.C. § 103(a) as unpatentable over
23 Chou, Katzman, and Monteleone.

ISSUES

The issue of obviousness turns primarily on whether it was predictable to use Katzman's instant messaging service in Katzman's purchasing management system during the requisition portion of the purchase cycle.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

Chou

01.Chou is directed to a tool that allows users who are not directly networked to a client/server requisition system to enter requisitions and inquire into the status of existing requisitions from a remote location using the Internet or an intranet. Chou ¶ 0002.

02.Chou describes generating a requisition for selectable items, using a client computer and server interconnected via a network. The client computer system is configured to allow a plurality of users to access the server. Chou ¶ 0008.

Katzman

03.Katzman is directed to communicating with at least one member in a computer system. Member profile information includes schedule information and member activity information. Vendor profile information includes a vendor determined predetermined condition and associated action to be taken in response to an

1 occurrence of a predetermined condition. A member is selected
2 based on the predetermined condition or an occurrence of said
3 predetermined condition. A preferred mode of communication is
4 automatically sent in accordance with said associated action to
5 said at least one member using said preferred mode of
6 communication. The communication is customized in accordance
7 with one of said scheduling information and said member activity
8 information. Katzman ¶ 0007.

9 04. The Order Wizard provides users who are members a targeted list
10 of goods and services specifically available to them. This may
11 include, for example, descriptions of the goods and/or services,
12 current pricing, promotional offers, shipping and inventory
13 availability, local and national vendor information, and other
14 necessary information. The Order Wizard may allow for direct
15 communications, via email, chat, bulletin boards, and other
16 Internet technologies with these suppliers in order to enhance
17 customer/supplier relationships. These MCS communication
18 capabilities may be rules-based and may automatically send
19 communications to both users and suppliers. Katzman ¶ 0028.

20 05. Instant messaging is an optional component for the chat described
21 *supra*. Katzman ¶ 0033 and 0039.

22 06. Katzman describes using instant messaging to confirm the vendor
23 will be able to deliver. This instant message occurs at the same
24 time the order is placed. The vendor responds back with instant

messaging recommending an order change. Katzman ¶ 0099-0100.

ANALYSIS

We are unpersuaded by Appellant’s argument that the art fails to describe the agent creating the requisition order during an instant messaging session. Appeal Br. 21. Appellant distinguishes Katzman, contending that Katzman performs instant messaging to confirm delivery rather than create the order. *Id.*

The Examiner responds that Chou describes creating a requisition on a server (see FF 01-02), and Katzman describes using instant messaging during purchasing activities (see FF 03- 06). Ans. 17-18. Katzman does not narrowly restrict instant messaging to only post order activity, and indeed even describes using instant messaging to change an order (FF 06) which is analogous to entering a new requisition. In any event, Katzman describes instant messaging as one of several communication tools for rapid response during purchasing, making it predictable to one of ordinary skill in the purchasing management arts to use such rapid communication during the requisition steps as well as any other steps in the purchasing cycle. There is nothing unusual about entering a requisition that would make the use of communication tools less predictable during that phase of the process.

We are further unpersuaded by the Appellant's argument that an instant messaging system has significantly less processing and memory capacity than a server and that the claim eliminates the need for a web site. Reply Br. 3-5. Appellant provides no evidence to support the assertions regarding the relative amounts of processing and memory capacity, and in any event,

1 while instant messaging may use much less of a server's capacity than the
2 maximum available, this is in the nature of a server so as to run plural
3 processes simultaneously. This argument does not even suggest that
4 Katzman's server would not use the instant messaging service that Katzman
5 explicitly describes.

6 As to the "thereby" clause that a need to use a web site would be
7 eliminated, it is the need to use, not the web site, that is the subject of the
8 verb "is eliminated." Because all of the pertinent information in a
9 requisition can be conveyed by any textual communication, including instant
10 messaging, the need to use a web site is simply inherently eliminated. More
11 to the point, the Examiner did make findings as to this limitation at Answer
12 12.

13 As to claim 24, reciting that the user and the agent must be currently
14 logged on to the instant messaging system in order for a message to be sent
15 from the user to the agent, we are unpersuaded by Appellant's argument that
16 the prior art does not require this. Appeal Br. 23.

17 The Examiner responds that both parties are clearly logged onto
18 Katzman's system (FF 04) which includes the instant messaging facility (FF
19 05-06). Ans. 18-19. Aside from this, plain common sense informs one of
20 ordinary skill that two way communication requires that each party be
21 connected, and logging in is simply one step in computer connection.

22 In rejecting rigid application of the "teaching, suggestion, or
23 motivation" test for obviousness, the Supreme Court observed
24 that common sense can be a source of reasons to combine or
25 modify prior art references to achieve the patented invention.

26 *Perfect Web Technologies, Inc. v. INFOUSA, Inc.*, 587 F.3d 1324, 1329 (Fed
27 Cir 2009).

CONCLUSIONS OF LAW

The rejection of claims 1-6, 19-22, and 24-32 under 35 U.S.C. § 103(a) as unpatentable over Chou and Katzman is proper.

The rejection of claim 23 under 35 U.S.C. § 103(a) as unpatentable over Chou, Katzman, and Monteleone is proper.

DECISION

The rejection of claims 1-6 and 19-32 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

MP